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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,996	03/13/2001	Hiroyuki Sekihata	1095.1170/JDH	9371
21171	7590	08/24/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			MCALLISTER, STEVEN B	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/803,996	Applicant(s) SEKIHATA ET AL.	
	Examiner Steven B. McAllister	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2005.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213..

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-12 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,2 and 5-12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/1/2005 has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 11 lacks any recitation of a technological element performing the method (e.g., a computer). The examiner acknowledges the amendment of the preamble to include that the system is connected via a network, but the body of the claim does not refer back to the technological element, such that it is a limitation on the method.

Note Regarding Examination

It is noted that as required by MPEP 2144.03(C), the statements that subject matter is "old and well known in the art" are interpreted as admitted prior art since such statements must be traversed in the subsequent reply.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6, 8, 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al in view of Saito et al (JP 11-110441)

Green et al show managing book stock information; managing bibliographic information; and managing loan information. Green et al do not show managing order information, ordering, receiving collation information, or transmitting received collation information to the vendor, wherein the collation information includes information identifying an individual library. Saito et al show managing order information and placing an order based on ordering information. Saito et al further show receiving collation information and transmitting collation information to the vendor, the collation information comprising an identifier or the orderer (comprising e.g., its code set). It would have been obvious to one of ordinary skill in the art to further modify the apparatus and method of Green et al by receiving and transmitting collation information

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in order streamline the ordering process and to track and close out the fulfillment process. It is noted that claims 1-10 are drawn to an apparatus, and the that the further definition of collation information is not further limiting on the claims. It is further noted that the "for ..." clauses of claims 1-10 are interpreted as statements of intended use, and the any apparatus structure capable of performing the recited use reads on the limitations.

As to claim 6, the ordering means is capable of placing an order at a price reduced in accordance with an order quantity.

Alternatively, Green in view of Saito et al show all elements of claim 6 except placing an order at a reduced price based on quantity. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to further modify the apparatus by placing an order at a reduced price based on quantity in order to save money.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al in view of Saito et al as applied to claim 1 above, and further in view of Rubin et al (6,078,897).

Green et al in view of Saito et al show all elements of the claim except a reduced price estimating means for estimating a reduced price. Rubin et al show a reduce price estimating means. It would have been obvious to one of ordinary skill in the art to

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further modify the apparatus of Green et al by using the discount estimator of Rubin et al in order more easily facilitate the use of volume discounts.

Claims 1, 2, 5, 6, 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epixtech in view of Saito et al (JP 11-110441).

Epixtech shows book stock information management means; bibliographic information management means; loan information management means; order information management means capable of managing information on books ordered by individual libraries; and ordering means capable of ordering based on the managed information. Epixtech does not explicitly show collation information receiving means capable of receiving collation information from the individual libraries, the collation information containing library identifiers; collation information transmitting means capable of transmitting the collation information to the vendor; or that the order information management means and ordering means are capable of dealing with ordering information from individual libraries. Saito shows means capable of receiving the claimed collation information comprising the central processing unit which is networked to the branches and means capable of transmitting the collation information to the vendor (see e.g., Fig. 1) and order information management means and ordering means capable of handling orders from individual libraries). It would have been obvious to one of ordinary skill in the art to further modify the apparatus and method of Epixtech by adding the elements of Saito in order streamline the ordering process and to track and close out the fulfillment process. It is noted that claims 1-10 are drawn to an

apparatus, and the that the further definition of collation information is not further limiting on the claims. It is further noted that the "for ..." clauses of claims 1-10 are interpreted as statements of intended use, and the any apparatus structure capable of performing the recited use reads on the limitations.

As to claim 2, Epixtech shows that the loan information management means enables a library to modify the loan information of another library since it checks books in and out on interlibrary loan and enters their status.

As to claim 5, Epixtech in view of Saito et al show a reservation means and a means for registering the books into the stock information means. It is noted that it is inherently possible to register an unreceived book into the database since only data is needed to populate the database. Epixtech does not explicitly show reserving loan of the unreserved book. It is further noted that it is possible to reserve an item in the database.

Alternatively, Epixtech in view of Saito et al show a reservation means and a means for registering the books into the stock information means. It is noted that it is inherently possible to register an unreceived book into the database since only data is needed to populate the database. Epixtech does not explicitly show reserving loan of the unreserved book. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the apparatus to allow for reservation before receipt in order to facilitate the timely use of materials and to provide better user service.

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As to claim 6, Epixtech in view of Saito et al show that the ordering means is capable of placing an order at a price reduced in accordance with an order quantity.

Alternatively, Epixtech in view of Saito et al show all elements of claim 6 except placing an order at a reduced price based on quantity. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to further modify the apparatus of Epixtech by placing an order at a reduced price based on quantity in order to save money.

As to claim 8, Epixtech in view of Saito et al show statistical information generating means.

As to claim 9, Epixtech in view of Saito et al show request receiving means, searching means, and result transmitting means.

As to claim 10, Epixtech in view of Saito et al show all elements except SDI keyword registration means and new information sending means. However, it is notoriously old and well known in the art to register a SDI keyword and receive information when a new book corresponding to that keyword is registered. It would have been obvious to one of ordinary skill in the art to do so in order to provide the user with relevant information automatically, saving labor.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

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As to the arguments regarding Saito, the examiner respectfully disagrees and believes that the reference shows means capable of receiving collation information and sending collation information to the wholesaler, since it shows receiving (and therefore means for receiving) information regarding the receipt and inspection of the materials by the individual libraries and means of sending this to the vendors.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is 571-272-6785. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven B. McAllister

Steven B. McAllister
Primary Examiner
Art Unit 3627

STEVE B. MCALLISTER
PRIMARY EXAMINER